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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EX PARTE JENNIFER CHAYES, CHRISTIAN H. BORGS,
AMIN SABERI, and MOHAMMAD MAHDIAN

Appeal 2010-000303
Application 10/603,034
Technology Center 2100

Before MARC S. HOFF, CARLA M. KRIVAK, and
ELENI MANTIS MERCADER, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims1-42. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' claimed invention is a system and method for organizing newsgroups via clustering. The invention utilizes cross-posts to cluster newsgroups. (Spec. 1: 5-7).

Independent claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A computer implemented system that facilitates analyzing news group clusters, comprising the following computer executable components:
>
> a data reception component that receives and recognizes data relating to a plurality of news groups; and
>
> an engine that constructs a weighted graph with a subset of the news groups represented as vertices of the graph, and cross-postings relating to the subset of news groups represented as edges.

REFERENCES and REJECTIONS

The Examiner rejected claims 1-15, 21-30, 32-39, 41, and 42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner rejected claims 1-42 under 35 U.S.C. § 103(a) based upon the teachings of Charles H.Q. Ding "*Analysis of gene expression profiles: class discovery and leaf ordering*", Proc. RECOMB 2002, pages 127-136, April 2002, Washington, D.C. (Ding) and Uomini (US 5,819,269, Oct. 6, 1998).

The Examiner rejected claims 35 and 38 under 35 U.S.C. § 103(a) based upon the teachings of Ding, Uomini, and Gage (US 5,923,846, Jul. 13, 1999).

ANALYSIS

Rejection Under 35 U.S.C. § 101

The Examiner rejected claims 1-15, 21-30, 32-39, 41, and 42 under 35 U.S.C. § 101 for failing to claim patent-eligible subject matter (Ans. 3-4). The Examiner addressed this rejection by citing to old case law regarding a useful, concrete and tangible result (Ans. 4) and Appellants responded that software code alone is statutory subject matter as clearly established by *Eolas Techs., Inc., v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d. 1352, 1358 (Fed. Cir. 1999) (App. Br. 5). We therefore find the grounds of rejection and argument moot and rely on *Bilski v. Kappos*, 130 S. Ct. 3218, 3231 (2010) for rejecting these claims.

Claim 1 recites a computer implemented system comprising the computer executable components including receiving and recognizing data and constructing a weighted graph. The specification recites the components as referring to "a computer-related entity either hardware, a combination of hardware and software, software, or software in execution" (Spec. 7:27-29). Because the components can be merely software, we regard the components as being steps executed by the software, i.e., process steps. These process steps are then considered under *Bilski* to determine if they are tied to a particular machine or apparatus or transform a particular article to a different state or thing. We find these steps do not satisfy either prong.

Claim 1 merely recites software for receiving data and constructing a graph based on the data received. Specifically, the claim is directed to software *per se*. That is, claim 1 does nothing more than receive data and graph the data. There is no reference to a specific machine by citing structural limitations to any apparatus, nor is there any recitation to any specific operations that would cause a machine to receive or construct a graph, etc. Thus, absent any specific structural limitations, claim 1 recites no more than an abstract concept. As to the "computer implemented system," even if some physical steps may be required to obtain information (e.g., entering data via a keyboard, clicking a mouse), such data-gathering steps cannot alone confer patentability. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011). Simply using a computer implemented system in some undefined manner, without more, cannot confer patent eligibility. Thus, claim 1 fails the "machine-or transformation test."

Having determined that claim 1 fails the machine-or-transformation test, we next consider whether any additional factors indicate that claim 1 is nonetheless patent-eligible. *See* Memorandum from Robert W. Bahr, Acting Assoc. Comm'r for Patent Examination Policy, U.S. Patent and Trademark Office, to the Patent Examining Corps, *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of* Bilski v. Kappos (July 27, 2010), *available at* Appeal 2010-008158 http://www.uspto.gov/patents/law/exam/bilski_guidance_27jul2010.pdf (including *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of* Bilski v. Kappos, 75 Fed. Reg. 43,922 (July 27, 2010) (notice)).

We are unable to identify any additional factors that would weigh towards eligibility. We therefore exercise our authority under 37 C.F.R. § 41.50(b), rejecting independent claim 1 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Claims 21 is a method claim that merely recites the manipulation of data and is therefore an abstract idea that is non-statutory under 35 U.S.C. § 101.

Although we decline to reject every claim under our discretionary authority under 37 C.F.R. § 41.50(b), we emphasize that our decision does not mean the remaining claims are patent eligible under § 101. Rather, we merely leave the patentability determination of these claims to the Examiner. *See* MPEP § 1213.02.

Rejection Under 35 U.S.C. § 103

Appellants argue claims 1-34, 36, 37, and 39-42 together (App. Br. 9). Appellants separately argue claims 35 and 38. However, the arguments presented rely on those with respect to claim 1 with a further statement that Gage fails to make up for the deficiencies of Ding and Uomini (App. Br. 9). Thus, this rejection is addressed with respect to claim 1, claims 2-42 standing or falling therewith.

The Examiner finds Ding discloses all the features of Appellants claim 1 except for the "cross-postings relating to the subset of newsgroups" and relies on Uomini for that teaching (Ans. 5-6).

Appellants contend Ding discloses clustering data related to tissue samples and gene responses, only briefly mentioning a clustering method for internet newsgroups, and fails to disclose what the vertices and edges are in

a weighted graph (App. Br. 7-8). That is, Appellants contend Ding does not teach or suggest newsgroups represented as vertices and cross postings related to newsgroups represented as edges as claimed (App. Br. 8). Appellants further assert Uomini only briefly mentions cross-posting to multiple news groups and is silent as to newsgroup clustering and weighted graphs (App, Br. 8).

Appellants merely state Ding does not provide what is represented on the weighted graph. Appellants have not addressed the Examiner's findings of these limitations in Ding (Ans. 31-33). Further, Appellants' contention in the Reply Brief that the Examiner issued a new ground of rejection is without merit. Ding cites to its related reference (see FN 11 of Ding). However, the Examiner merely cited Ding IEEE as showing support for the weighted graph algorithm in Ding (Ans. 31-32).

Thus, for the reasons set forth by the Examiner, we find claims 1-42 obvious over Ding and Uomini.

DECISION

The Examiner's decision rejecting claims 1-42 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2010).

AFFIRMED

Vsh